II. Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1, 3, 4, 7, and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,909,488 to Consoli ("Consoli"). According to the Examiner, "the cited reference teaches the claimed invention including a resilient covering comprising polyvinyl and urethane based acrylate containing aluminum oxide." Office Action at 2. Applicants respectfully disagree for at least the following reasons.

For a reference to be anticipatory under 35 U.S.C. § 102, the reference must teach each and every element as set forth in the claim. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. Moreover, the reference must show the identical invention in as much detail as in the claims. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131. As shown below, Consoli does not teach each and every element as set forth in the claims, thus does not anticipate the claimed invention.

The claimed invention is directed to a "resilient surface covering having improved wear and/or stain resistance comprising a wear layer, said wear layer comprising a radiation or electron beam curable urethane based acrylate and aluminum oxide." Contrary to the Examiner's assertion, Consoli does not teach a urethane based acrylate but vinyl compositions. Indeed, the specific teaching relied on by the Examiner, states, in relevant part:

> Suitable resins can be employed in the present invention are those which can be solvated by a plasticizer and which can be coated with the lubricant such as polyvinyl chloride, polyvinyl acetate, vinyl chloride-vinyl acetate copolymers, polyvinylidene chloride, or the

like.

Col. 2, lines 53-58. In other words, the requirements of Consoli's resin is one that (1) can be solvated by a plasticizer and (2) can be coated with a lubricant. The resins that Consoli teach meet these requirements are vinyl-based, not urethane based acrylates, and certainly not urethane based acrylates that are radiation or electron beam curable. For this reason alone, Consoli does not anticipate claims 1, 3, 4, 7, and 11.

Furthermore, the claimed invention is directed to aluminum oxide contained in the wear layer that "has an average particle size of about 10 microns to about 70 microns and is present in an amount up to and including about 40% by weight of the wear layer." Consoli never mentions the size of the filler particles or a wear layer in which such particles are located. For these additional reasons, there can be no anticipation.

In addition, as this reference does not teach a wear layer, it certainly cannot teach aluminum oxide present in an amount up to and including about 40% by weight of the wear layer, as claimed. In fact, this reference is exclusively directed to and specifically exemplifies compositions containing much higher amounts of a filler. For example, this reference is directed to vinyl compositions (not surface coverings per se) and "processes for forming such vinyl compositions containing high concentrations of fillers, e.g., in the order of up to about 2500 weight percent based on the vinyl polymer." Col. 1, lines 48-51.

In order to achieve such high loadings, this reference teaches the use of a lubricant, which is added in a particular manner, e.g., to a powdered, unplasticized, vinyl polymer prior to adding a plasticizer. In particular, this reference teaches:

> The present invention is based upon the discovery that **when a lubricant composition**, and a filler are added to a powdered, unplasticized, vinyl polymer composition prior to adding a plasticizer to the vinyl polymer composition addition of particulate fillers in **very high concentrations can be obtained**.

Id. at lines 52-58.

In describing the "representative suitable fillers," Consoli teaches that "compositions of this invention contain fillers in concentrations above about 300 weight percent and up to about 2500 weight percent, based upon the weight of the vinyl polymer." Id. at col. 3, lines 16-22.

For the additional reason that Consoli does not teach or suggest aluminum oxide is present in an amount up to and including about 40% by weight of the wear layer, as claimed, it cannot anticipate the claimed invention.

In view of the foregoing, it is clear that Consoli does not teach each and every element of the claimed invention, and thus is not anticipatory under 35 U.S.C. § 102(b). Applicants thus submit that this rejection is improper and request that it be withdrawn.

III. Rejections Under 35 U.S.C. §103

A. The Examiner has rejected claims 2, 5, 6, 8-10, 13, and 30-53 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,670,237 to Shultz et al. ("Shultz") in view of Consoli. Applicants respectfully traverse this rejection as being improper under 35 U.S.C. §103(c), since the Shultz patent is not prior art to the pending claims. *See*, MPEP 706.02(l)(3). Rather, 35 U.S.C. §103 now states that prior art under §102(e) (as is the Shultz patent since Applicants rightfully claimed the benefit of priority to provisional application 60/038,879, filed February 20, 1997, which is before the

September 23, 1997 issue date for the Shultz patent)[1] shall not preclude the patentability of an invention, if: (1) the invention was developed by another person; and (2) was commonly owned or subject to an obligation of assignment to the same entity.

In the present application, Chen and Rufus are listed as co-inventors, whereas Shultz and Crispin are listed as the co-inventors on U.S. Patent No. 5,670,237 to Shultz. Thus, the claimed invention was developed by "another person."

The common assignment of both the Shultz patent and the present application to Mannington satisfies the second requirement. A copy of the recordation cover sheet evidencing the obligation of assignment to the same entity, Mannington, is attached herewith. Thus, both requirements for triggering the provision of 103(c) are met.

Finally, this statutory provision applies to any application filed on or after November 29, 1999, which is clearly met by the present application, which was filed on April 9, 2001.

As the Shultz patent is not prior art to the pending claims, Applicants submit that this rejection is improper and respectfully request that it be withdrawn.

B. The Examiner has rejected claim 12 under 35 U.S.C. §103 as being unpatentable over Consoli in view of U.S. Patent No. 5,401,560 to Williams ("Williams"). According to the Examiner, Williams teaches that it is known in the art to apply the

[1] A copy of the declaration filed with the parent application, 08/956,022, now US Patent No. 6,291,078B1, is of record in this application. The declaration expressly claims the benefit of priority to provisional application 60/038,879, filed February 20, 1997. *See, e.g.,* MPEP 201.11 (stating that an application for a patent is entitled to the benefit of the filing date of a provisional application which has at least one common inventor).

above coating (obvious combined teachings of the references above) on wood product." Applicants respectfully disagree for at least the following reasons.

To establish a prima facie case of obviousness, the prior art must teach or suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. Moreover, the prior art must teach all of the limitations recited in the present claims. *See* M.P.E.P. § 2143.03. The Examiner has failed to establish a prima facie case of obviousness here, at least because the cited art does not teach or suggest the desirability of the claimed invention, and further fails to teach all of the elements recited in the present claims.

As shown above, Consoli has multiple fundamental deficiencies that Williams does not cure. Indeed, the Examiner admittedly only relies on this reference for its teaching of applying a coating on a wood product. Assuming, for the sake of argument only, that the Examiner's assertion of Williams

The combination of Consoli and Williams neither teaches nor suggests the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: November 20, 2006

By: Reg. No. 41,469
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